UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,297	09/26/2003	Ken R. Powell	104.005-04	6455

38245 7590 06/22/2007		EXAMINER
JEROME D. JACKSON (JACKSON PATENT LAW OFFICE) 211 N. UNION STREET, SUITE 100 ALEXANDRIA, VA 22314		SALIARD, SHANNON S

ART UNIT	PAPER NUMBER
3628	

MAIL DATE	DELIVERY MODE
06/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/670,297	POWELL, KEN R.
	Examiner	**Art Unit**	
	Shannon S. Saliard	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 March 2007</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-7</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-7</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 March 2007 has been entered.

Status of Claims

2. Applicant has amended claims 1-5. No claims have been cancelled or newly added. Thus, claims 1-7 remain pending and are presented for examination.

Response to Arguments

3. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 03 April 2007 was filed has been considered by the examiner.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   **Claim 1** is rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et

al [US 5,855,007] in view of Nemirofsky [US 5,953,047], and Valencia et al [US

5,380,991].

As per **claim 1**, Jovicic et al discloses (a) transmitting to the user computer via

the global computer network, data referring to the product [col 7, lines 56-64];

(b) subsequently receiving from the user computer, via the global computer network,

data indicating that the user desires to receive a coupon for the product [col 8, lines 1-

10]; (c) responsive to the receiving step, transmitting to the user computer via the global

computer network, coupon data representative of the coupon [col 8, lines 32-39].

Jovicic et al does not explicitly disclose using an address associated with the user

computer. However, Jovicic et al discloses the Internet node communicates using

Internet Protocol (IP) with another computer connected to the Internet [col 5, lines 32-

40, networks using IP protocol route messages based on IP address]. Therefore, it

would have been obvious to one of ordinary skill in the art at the time of the invention to

modify the invention of Jovicic et al to include using an address associated with the user

computer so that the computer knows where to send the information.

Jovicic et al does not disclose (d) writing the coupon data, transmitted in step (c), onto

the smart card. However, Nemirofsky discloses transmitting coupon data to a computer

screen over a computer network and writing the coupon data onto a smart card [col 8,

lines 20-24]. Therefore, it would have been obvious to one of ordinary skill in the art at

the time of the invention to modify the invention of Jovicic et al to include the method

disclosed by Nemirofsky. Nemirofsky provides the motivation that the invention

achieves real-time interactivity and is convenient for consumers [col 1, lines 48-50].

Jovicic et al does not disclose writing the coupon data onto a smart card with the smart

card reader/writer. However, Valencia discloses a paperless coupon redemption

system and method that includes a smart card and the terminal device (including card

reader/writer) in communication with the card so as to write the data into the smart card

and the POS reads the smart card with the reader/writer (Fig. 5). Therefore, it would

have been obvious to one of ordinary skill in the art at the time of the invention to modify

the invention of Jovicic et al to include the method disclosed by Valencia et al. Valencia

provides the motivation that the method allows a shopper to obtain the benefit of

reduced prices for certain items without the necessity of redeeming paper coupons

[Abstract].

7.   **Claims 2-4** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Jovicic et al [US 5,855,007] in view of Nemirofsky [US 5,953,047], Valencia et al [US

5,380,991], and Christensen et al [U.S. Patent 5,710,886].

As per **claims 2-4**, Jovicic et al discloses (a) transmitting to the user computer

via the global computer network, data referring to the product [col 7, lines 56-64];

(b) subsequently receiving from the user computer, via the global computer network,

data indicating that the user desires to receive a coupon for the product [col 8, lines 1-

10]; (c) responsive to the receiving step, transmitting to the user computer via the global

computer network, coupon data representative of the coupon [col 8, lines 32-39].

Jovicic et al does not explicitly disclose using an address associated with the user

computer. However, Jovicic et al discloses the Internet node communicates using

Internet Protocol (IP) with another computer connected to the Internet [col 5, lines 32-

40, networks using IP protocol route messages based on IP address]. Therefore, it

would have been obvious to one of ordinary skill in the art at the time of the invention to

modify the invention of Jovicic et al to include using an address associated with the user

computer so that the computer knows where to send the information.

Jovicic et al does not disclose (d) writing the coupon data, transmitted in step (c), onto

the smart card. However, Nemirofsky discloses transmitting coupon data to a computer

screen over a computer network and writing the coupon data onto a smart card [col 8,

lines 20-24]. Therefore, it would have been obvious to one of ordinary skill in the art at

the time of the invention to modify the invention of Jovicic et al to include the method

disclosed by Nemirofsky. Nemirofsky provides the motivation that the invention

achieves real-time interactivity and is convenient for consumers [col 1, lines 48-50].

Jovicic et al does not disclose writing the coupon data onto a smart card with the smart

card reader/writer; (e) reading the coupon data with the second smart card

reader/writer; (f) determining if a list of products, being purchased by the user, includes data corresponding to the coupon data; and (g) if the list of products includes data corresponding to the coupon data, then crediting the user with an amount indicated by the coupon data. However, Valencia discloses a paperless coupon redemption system and method that includes a smart card and the terminal device (including card reader/writer) in communication with the card so as to write the data into the smart card and the POS reads the smart card with the reader/writer (Fig. 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Jovicic et al to include the method disclosed by Valencia et al. Valencia provides the motivation that the method allows a shopper to obtain the benefit of reduced prices for certain items without the necessity of redeeming paper coupons [Abstract]. Moreover, Christensen et al discloses transmitting to coupon data to a user computer, via a global computer network [col 8, lines 42-col 9, lines 8; see fig, 10-13]; reading the coupon data; determining if a list of products includes data corresponding to the coupon data; and reporting the coupon information to a clearinghouse [col 15, lines 20-col 16, lines 26]. Also, the Examiner takes Official Notice that it is old and well known in the coupon industry to credit a customer with an amount indicated by the coupon. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Nemirofsky et al to include the methods disclosed by Christensen et al including crediting the user with amount indicated by the coupon data. Valencia et al provides the motivation that the invention avoids the traditional problems in which paper coupons must be distributed by a manufacturer,

retained by a customer, brought to a consumer outlet, organized at a checkout station,

inspected to determine whether the coupons are expired and then redeemed at a

central clearinghouse [col 2, lines 51-58].

8.   **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et

al [US 5,855,007] in view of Jones [US 5,500,681], and Valencia et al [US 5,380,991].

As per **claim 5**, Jovicic et al discloses (a) viewing a plurality of available

downloadable coupons, received in a packet having an address associated with the

user computer in the global computer network, on the computer monitor;

(b) subsequently generating an input to the computer indicating a selection of a selected

coupon from the plurality of available downloadable coupons [col 8, lines 1-17];

(c) receiving data corresponding to the selected coupon, the received data having been

transmitted using the address through the global computer network after step (b) [col 8,

lines 32-39]. Jovicic et al does not explicitly disclose using an address associated with

the user computer. However, Jovicic et al discloses the Internet node communicates

using Internet Protocol (IP) with another computer connected to the Internet [col 5, lines

32-40, networks using IP protocol route messages based on IP address]. Therefore, it

would have been obvious to one of ordinary skill in the art at the time of the invention to

modify the invention of Jovicic et al to include using an address associated with the user

computer so that the computer knows where to send the information. Jovicic et al does

not further disclose receiving the coupon is a packet. However, Jones et al discloses

transmitting selected coupon to a user through the use of a packet [col 4, lines 9-27 and

39-49]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Jovicic et al to include the method disclosed by Jones et al to transmit longer messages more efficiently and reliably. Jovicic et al does not disclose causing the received data to be written to the smart card; and (d) presenting the smart card to a smart card reader/writer at the store while purchasing a product corresponding to the coupon; (e) whereby the store applies a credit specified by the coupon data to a purchase price of the product. However, Valencia et al discloses a paperless coupon redemption system and method in which a smart card is presented to a reader/writer while purchasing a product at a store [col 9, lines 40-53]. Also, the Examiner takes Official Notice that it is and well known in the coupon industry to credit a customer with an amount indicated by the coupon. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Jovicic et al to include the disclosed by Valencia et including crediting a customer with an amount indicated by the coupon. Valencia et al provides the motivation that the invention avoids the traditional problems in which paper coupons must be distributed by a manufacturer, retained by a customer, brought to a consumer outlet, organized at a checkout station, inspected to determine whether the coupons are expired and then redeemed at a central clearing house [col 2, lines 51-58].

9.　　**Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Valencia

et al [U.S. Patent 5,380,991] in view of Jovicic et al [US 5,855,007] and Nemirofsky et al

[U.S. Patent No. 6,505,773].

　　　　As per **claim 6**, Valencia et al discloses (a) a processor in communication

with a computer network [see col.4 lines 14-15, the host computer or computer system

being coupled to the smart card: col 8, lines 15-19]; (b) a smart card reader/writer

circuit, in communication with the processor, capable of writing data to a smart card

[see col. 4, lines 4-26; col 6, lines 29- 30 for using reader/writer]; and (c) a program that

receives a user selection, and causes the processor to write data that is received via the

global computer network onto a smart card via the smart card reader/writer circuit [col.

4,lines 30-36]. Valencia et al does not teach that a program receives coupon data

having been transmitted through the global computer network after the program sends

the corresponding selection through the global network. However, Jovicic et al discloses

transmitting to the user computer via the global computer network, data referring to the

product [col 7, lines 56-64]; subsequently receiving from the user computer, via the

global computer network, data indicating that the user desires to receive a coupon for

the product [col 8, lines 1-10] and (c) responsive to the receiving step, transmitting to

the user computer via the global computer network, coupon data representative of the

coupon [col 8, lines 32-39]. Therefore, it would have been obvious to one of ordinary

skill in the art at the time of the invention to modify the invention of Valencia et al to

include the method disclosed by Jovicic et al. Jovicic et al provides the motivation that

the invention that consumer significantly decrease the amount of time and effort

expended in locating, clipping, and assembling of coupons [col 2, lines 20-39]. Valencia

et al does not disclose causing the processor to write coupon data from the user

computer onto a smart card. However, Nemirofsky discloses transmitting coupon data

to a computer screen over a computer network and writing the coupon data onto a

smart card [col 8, lines 20-24]. Therefore, it would have been obvious to one of ordinary

skill in the art at the time of the invention to modify the invention of Jovicic et al to

include the method disclosed by Nemirofsky. Nemirofsky provides the motivation that

the invention achieves real-time interactivity and is convenient for consumers [col 1,

lines 48-50].

10.   **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over

Christensen et al [U.S. Patent 5,710,886] in view of Jovicic et al [US 5,855,007],

Nemirofsky [US 5,953,047], and Valencia et al [US 5,380,991].

As per **claim 7**, Christensen et al discloses (a) a processor in communication

with a global computer network [Fig. 2]; and a checkout station, for reading the coupon

data stored on the smart card held by a user, including: (a) a cash register;

(b) a processor in communication with the cash register and with a telecommunications

link [see Fig. 2]; (d) a program that executes the steps of: (i) reading coupon data on the

smart card with the second smart card reader/writer; (ii) determining if a list of products,

being purchased by the user, includes data corresponding to the coupon data; (iv)

reporting the coupon to a coupon clearinghouse via the telecommunications link [col 15,

line 20-col 16, line 26]. Christensen et al does not disclose (c) a program that receives

a user selection, sends the received selection through the global computer network,

receives coupon data corresponding to the selection, the received coupon data having

been transmitted through the global computer network after the program sends the

corresponding selection through the global computer network. However, Jovicic et al

discloses transmitting to the user computer via the global computer network, data

referring to the product [col 7, lines 56-64]; subsequently receiving from the user

computer, via the global computer network, data indicating that the user desires to

receive a coupon for the product [col 8, lines 1-10] and (c) responsive to the receiving

step, transmitting to the user computer via the global computer network, coupon data

representative of the coupon [col 8, lines 32-39]. Therefore, it would have been obvious

to one of ordinary skill in the art at the time of the invention to modify the invention of

Christensen et al to include the method disclosed by Jovicic et al. Jovicic et al provides

the motivation that the invention that consumer significantly decrease the amount of

time and effort expended in locating, clipping, and assembling of coupons [col 2, lines

20-39]. Christensen et al does not disclose causing the processor to write the coupon

data that is received via the global computer network onto a smart card via the first card

reader/writer. However, Nemirofsky discloses transmitting coupon data to a computer

screen over a computer network and writing the coupon data onto a smart card [col 8,

lines 20-24]. Therefore, it would have been obvious to one of ordinary skill in the art at

the time of the invention to modify the invention of Christensen et al to include the

method disclosed by Nemirofsky. Nemirofsky provides the motivation that the invention

achieves real-time interactivity and is convenient for consumers [col 1, lines 48-50].

Furthermore, Valencia discloses a paperless coupon redemption system and method

that includes a smart card and the terminal device (including card reader/writer) in

communication with the card so as to write the data into the smart card and the POS

reads the smart card with the reader/writer (Fig. 5). Therefore, it would have been

obvious to one of ordinary skill in the art at the time of the invention to modify the

invention of Christensen et al to include the method disclosed by Valencia et al.

Valencia provides the motivation that the method allows a shopper to obtain the benefit

of reduced prices for certain items without the necessity of redeeming paper coupons

[Abstract]. Christensen et al does not disclose (iii) if the list of products includes data

corresponding to the coupon data, then crediting the user with a refund of an amount

indicated by the coupon data. However, the Examiner takes Official Notice that it is and

well known in the coupon industry to credit a customer with an amount indicated by the

coupon. Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to modify the invention of Christensen et al to include the disclosed

by Valencia et including crediting a customer with an amount indicated by the coupon.

Valencia et al provides the motivation that the invention avoids the traditional problems

in which paper coupons must be distributed by a manufacturer, retained by a customer,

brought to a consumer outlet, organized at a checkout station, inspected to determine

whether the coupons are expired and then redeemed at a central clearing house [col 2,

lines 51-58].

Conclusion

<u>Examiner's Note:</u> Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shannon S. Saliard whose telephone number is 571-272-5587. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.
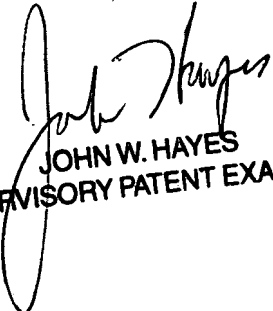
Please address mail to be delivered by the United States Postal Service (USPS) as follows:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(571) 273-5587 [Informal/ Draft Communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314

JOHN W. HAYES
SUPERVISORY PATENT EXAMINER

Shannon S Saliard
Examiner
Art Unit 3628

sss